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R.J.H

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Gordon R. MEYER et al.)	Group Art Unit: 2173
Application No.: 09/074,544)	Examiner: B. Huynh
Filed: May 8, 1998)	Appeal No.: 2002-0634
For: METHOD FOR DYNAMICALLY)	
GENERATING A "TABLE OF)	
CONTENTS" VIEW OF A HTML-)	
BASED INFORMATION SYSTEM)	

SUPPLEMENTAL REPLY BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Supplemental Examiner's Answer issued on January 26, 2004, the following is provided to respond to the new arguments raised therein.

INTRODUCTION

Prior to addressing the new arguments raised in the Supplemental Examiner's answer, there is an issue raised in the Remand to the Examiner ("Remand") which needs to be addressed.

In the Remand it is noted that Appellants withdrew claims 1 and 24 from appeal. The Remand indicates that a corresponding basis appears to exist for withdrawing claims 18 and 41 from the appeal. Appellants hereby withdraw claim 41 from the appeal. However, it is respectfully submitted that the appeal of claim 18 should continue. Specifically, claim 18 recites a number of elements which are not present in claims 1 and 24. For example, claim 18 recites "activating said help system" while claim 1 recites "activating a computerized information system." Additionally, the two determining steps of claim 18 are not present in claim 1.

Because claim 18 recites subject matter that is not recited in claim 1, Appellants hereby continue the appeal of this claim.

THE REASONING PROVIDED TO SUPPORT THE REJECTION OF CLAIMS 6-15,
29-38 AND 46-59 IS NOT PROPER

Claims 6-15, 29-38 and 46-59 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,055,544 to DeRose et al. ("DeRose"). MPEP §2131.01 discusses the requirements for anticipation under 35 U.S.C. §102. This section, citing Verdegaal Bros. v. Union Oil Company of California, 814F.2d 628, 631, to U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987), states that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

It is respectfully submitted that the reasoning to support the anticipation rejection of claims 6-15, 29-38 and 46-59 in the Response to Arguments section of the Supplemental Examiner's Answer is not proper for an anticipation rejection. Specifically, the Response to Arguments section states that the "self-contained objects" disclosed by DeRose "are equivalent to files." However, DeRose makes clear that the disclosed invention avoids "maintaining separate data files of each portion of the document." (Col. 4, lines 34-39). DeRose describes that the indexing process is performed to determine "the number of times a word is found in each element and sub-element of different levels of **a document**." (Col. 10, lines 63-66, emphasis added).

To support the alleged equivalence between the "self-contained objects" of DeRose and the files recited in Appellants' claims, the Examiner relies upon the disclosure of non-text objects of DeRose. DeRose, at column 8, lines 43-46 discusses the non-text objects. This section of DeRose discloses artwork elements 64 which "may be used to point to non-text objects, such as graphic raster files, which also may be separate electronic documents." However, DeRose discloses indexing the number of occurrences of words in different levels of a document. DeRose does not expressly or inherently disclose that the graphic raster files are indexed. Accordingly, the disclosure by DeRose of non-text objects cannot be

interpreted as the "files of a first type" which are recited in Appellants' claim 6 as being indexed.

In the absence of an express or inherent disclosure in DeRose of an equivalence between the "self-contained objects" and files, the equivalence alleged by the Examiner is not proper to support an anticipation rejection. Because DeRose clearly discloses that indexing is performed for different levels of **a document**, DeRose does not expressly or inherently disclose "indexing each file and a first level of each book of a predetermined folder for **files** of a first type" as recited in Appellant's claim 6¹. (Emphasis added).

Additionally, it is respectfully submitted that DeRose does not expressly or inherently disclose "scanning said files of a first type for at least one HTML meta-tag of a predetermined type in order to determine first data to be added to a first table of contents" as recited in Appellants' claim 6. The Supplemental Examiner's Answer states that the "overall contexts of DeRose's invention is to permit the ability of prior art fixed documents to be modified...when new tags are therefore added to prior art HTML mark-up language versions of these documents." However, the system of DeRose operates on SGML documents. (Col. 9, lines 28-38). It is only when a fragment of a document is accessed that the system down-converts the SGML document into an HTML document. (Col. 12, lines 28-43). Accordingly, the statement on page 13 of the Supplemental Examiner's Answer that DeRose discloses that "the operation manual is scanned for HTML tags" is not supported by the disclosure of DeRose. Because DeRose operates on SGML documents, DeRose does not expressly or inherently disclose scanning files "for at least one HTML meta-tag" as recited in Appellants' claim 6².

¹ Claims 29 and 46 respectively recite a system and computer-readable medium with similar elements to those discussed above with regard to claim 6, and hence, DeRose does not disclose these similar elements recited in claims 29 and 46.

² Claims 29 and 46 respectively recite a system and computer-readable medium with similar elements to those discussed above with regard to claim 6, and hence, DeRose does not disclose these similar elements recited in claims 29 and 46.

Because the Examiner's reasoning to support the interpretation portions of a document as being separate files is not expressly or inherently present in the disclosure of DeRose, this reasoning is improper to support an anticipation rejection.

THE EXAMINER IS MISCHARACTERIZING APPELLANTS' PREVIOUS ARGUMENTS

In the Response To Arguments section the Examiner asserts that Appellants admit that DeRose discloses "a document folder broken down into a hierarchy of books, chapters, pages...(Brief's page 6, 2nd par.)." Although it is unclear if the Examiner is referring to the Brief for Appellant or the Reply Brief, it is respectfully submitted that neither of these documents includes such a statement. Specifically, in the first full paragraph on page 6 of the Brief for Appellant it is stated that DeRose discloses that "a document is broken down into parts (e.g., books, chapters, pages, and so forth)." However, contrary to the Examiner's assertions, Appellants' have not admitted that DeRose discloses "a **document folder** broken down into a hierarchy." (Emphasis added).

THE EXAMINER MISCHARACTERIZES APPELLANTS' CLAIMS

In the Supplemental Examiner's Answer the rejection of claims 6, 29 and 46 states that DeRose discloses "dynamically generating a table of contents...using a template...in response to the activation." However, Appellants claims 6, 29 and 46 do not recite a step of dynamic generating a table, that the generation of the table uses a template, or that the generation of the table is performed "in response to the activation." The Supplemental Examiner's Answer includes numerous additional mischaracterizations of Appellants' claims. Accordingly, it is respectfully submitted that the evaluation of the patentability of Appellants' claims should be based on the language recited in the claims and not on the mischaracterization provided in the Supplemental Examiner's Answer.

THE EXAMINER IS IMPROPERLY INTERPRETING THE CONCEPTS OF A TABLE OF CONTENTS AND AN INDEX

It appears that the Examiner is improperly using the concepts of a table of contents and an index interchangeably. This is particularly relevant because while DeRose discloses the generation of a table of contents, Walls merely discloses the generation of an index. On page 11 of the Supplemental Examiner's Answer it is stated that figure 9 of DeRose "discloses a Table-of-Content 160 which is an index of files." However, DeRose makes clear that a table of content is not an index. DeRose discloses the generation of a table of contents. Additionally, DeRose discloses that the terms of the document for which a table of contents is generated can be indexed. (Col. 10, lines 54-67). The number of occurrences of a user search term (i.e., the index value) can be displayed next to the chapter and section titles in the table of contents. Because DeRose makes clear that there is a difference between the generation of a table of contents and the indexing of terms in a document, the Examiner's interpretation of the generation of an index as the same as the generation of a table of contents is not proper.

CONCLUSION

In addition to the reasons set forth in the Brief for Appellant, it is respectfully submitted that in view of the arguments above the Examiner's rejections of Appellants' claims should be reversed.

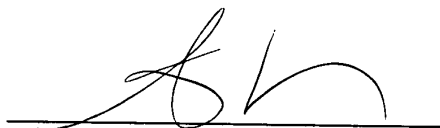
Respectfully submitted,

Burns, Doane, Swecker & Mathis, L.L.P.

Date

2/23/04

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